

P19789.A15

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kyoji SAITO

Appl. No. : 09/618,716

Filed : July 18, 2000

For : APPARATUS AND METHOD FOR RECEIVING IMAGE



Group Art Unit: 2154

Examiner: Kenny S. Lin

Confirmation No. 954

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Final Action
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Official Action dated December 1, 2005, in which a three-month shortened statutory period for response was set to expire on March 1, 2006, and for which a Notice of Appeal (and the requisite fee) are being filed concurrently herewith, Applicant respectfully requests a Pre-Appeal Brief panel to review and withdraw the outstanding rejections set forth in the above-mentioned Official Action in view of the herein contained remarks.

Remarks begin on page 2 of this paper.

REMARKS

The present Request for Review will only address features of the independent claims because those arguments are dispositive of all the other claims in the case. However, by arguing the features of the independent claims. Applicant does not acquiesce in the propriety of the rejections and assertions made by the Examiner with respect to the dependent claims. Further, by asserting certain arguments, Applicant does not waive any other arguments but is concentrating on the clearest defects of the rejections.

The Examiner rejected independent claims 13 and 20 under 35 U.S.C. § 103(a) as unpatentable over TOYODA et al. (U.S. Patent No. 5,812,278) in view of RFC 2305 (RFC2305- "A Simple Mode of Facsimile Using Internet Mail" March 1998). The above rejection is traversed.

Claim 13 recites, inter alia, a controller that is configured "to judge whether or not the received e-mail is an error mail... based on whether a header of the received e-mail includes a predetermined character string". The Examiner asserts that this feature is disclosed by TOYODA et al. The Examiner's assertion is incorrect.

TOYODA et al. merely discloses whether or not an error occurs in a transmission of printed data to a facsimile. TOYODA et al. does not disclose judging whether received e-mail is error mail based on the contents of a header. Nor does TOYODA et al. disclose a header of a received e-mail which includes a predetermined character string that is related to a sender of the error mail.

To support his position, the Examiner relies on various enumerated portions of the TOYODA et al. disclosure. However, none of these portions of TOYODA et al.

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relate to the above-noted features of Applicant's invention. Moreover, the above-noted recited features of Applicant's invention is not disclosed in any other portion of TOYODA et al. (or in RFC 23056). Thus, contrary to the Examiner's assertion, TOYODA et al. does not disclose a controller that judges whether or not received e-mail is an error mail "based on" whether or not a header of the received e-mail includes a predetermined character string.

The Examiner admits that TOYODA et al. does not teach a "predetermined character string... related to a sender of the error mail" and relies upon RFC 2305 for this feature. The Examiner is again incorrect as RFC 2305 does not disclose this feature. The Examiner relies on various enumerated portions of the RFC document to support his position. While these portions deal with mail headers and various security considerations generally, they do not disclose a predetermined character string (in a header of a received e-mail) that is related to a sender of error mail. At least because of these shortcomings of each of the references cited by the Examiner, no proper combination of these references can disclose the combination of features recited in Applicant's claims 13 and 20 and according, these claims are allowable.

Furthermore, RFC does not relate to judging whether or not received e-mail is error mail. Thus, there is no motivation to combine the teachings of RFC with the disclosure of TOYODA et al. While TOYODA et al. does provide a generic statement that modifications are possible, TOYODA et al. certainly provides no motivation for modifying the image apparatus of TOYODA et al. as proposed by the Examiner. Moreover, RFC does not overcome the above-noted shortcomings of TOYODA et al.

Claims 16-19, 23-27 and 32 were rejected under 35 U.S.C. § 103 as unpatentable over TOYODA et al. in view of PRAITIS et al. (U.S. Patent No. 6,594,697) and MORI (U.S. Patent No. 6,417,930). Claim 16 (as an example only) requires, inter alia, a controller configured "to search for predetermined image data fixed code in an image data part of a body of an e-mail" and that judges a received e-mail as error mail when the predetermined image data fixed code is detected. At least this feature is not disclosed or rendered obvious by any of the references or by any combination relied upon by the Examiner.

The Examiner acknowledged that TOYODA et al. does not disclose a controller configured to "search", or to "judge" as recited in Applicant's claims. The Examiner relies on PRAITIS et al. for this feature. However, PRAITIS et al. does not relate to an e-mail as recited in Applicant's claims but relates to a command (not an e-mail) communicated between a browser module and a network software module and to detecting errors in a server using status code numbers contained in a response header. Thus, PRAITIS et al. cannot disclose a controller which searches for a predetermined image data fixed code "in the image data part of the e-mail". PRAITIS et al. also cannot disclose a controller which judges whether or not a received e-mail is error mail when a predetermined image data code is detected in an image data part of the body of an e-mail.

The Examiner admits that TOYODA et al. and PRAITIS et al. do not teach a multi/part structure electronic message having a predetermined data fixed code and relies on MORI for this teaching. However, the boundary code that the Examiner equates to the predetermined image data fixed code is contained in the "header" of an

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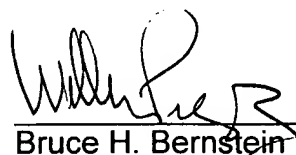
e-mail, but not in the "image data part of the body" of the e-mail as recited in Applicant's claims. Moreover, MORI is not related to judging that received e-mail is an error mail.

In addition to all of the shortcomings of the individuals references, the Examiner has set forth no proper basis for modifying the error judging Internet facsimile apparatus of TOYODA et al. using the browser of PRAITIS et al. and the facsimile apparatus of MORI that is not related to error messages. Even the proposed combination does not contain a teaching of the "search" and "judge" recitations of the claims.

Accordingly, each of Applicant's claims 13-29 and 31-34 are submitted to be clearly patentable over the various combinations asserted by the Examiner. Accordingly, Applicant respectfully requests withdrawal of each of the outstanding rejections.

Should the Examiner have any questions or comments regarding this paper, or the present application, the Examiner is respectfully requested to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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March 1, 2006
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